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Rec'd 5/30/02

From: DCHGreg@aol.com**Sent:** Wednesday, May 29, 2002 6:07 PM**To:** paper-removal@uspto.gov**Subject:** Comments on Proposal to Remove Paper

In a Federal Register Notice dated April 9, 2002, the PTO requested public comments on its development of a plan to eliminate the paper patent and trademark registration collections from its public search facilities and transition to electronic patent and trademark information collections. Attached hereto are comments of Section of Intellectual Property Law of the American Bar Association on the proposal, which comments are submitted at the direction of IPL Section Chair Charles P. Baker.

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6/3/02

AMERICAN BAR ASSOCIATION SECTION OF INTELLECTUAL PROPERTY LAW

Comments Responsive to PTO Notice of April 9, 2002 On Proposed Plan for an Electronic Public Search Facility And Request For Comments

In the Federal Register Notice dated April 9, 2002, the PTO requested public comments on its development of a plan to eliminate the paper patent and trademark registration collections from its public search facilities and transition to electronic patent and trademark information collections. The comments of the Section of Intellectual Property Law of the American Bar Association on this proposal follow.

I. PATENT FILES

A. MAINTAIN THE PUBLIC SEARCH ROOM

The American Bar Association Section of Intellectual Property Law ("IPL Section") continues to oppose, at least until an equivalent or better electronic system is demonstrated, the removal of the paper patent files from the PTO facilities, on the grounds that the paper files continue to be an important tool for searching patents.

B. MINIMIZE DELETERIOUS EFFECTS OF PAPER FILE REMOVAL

The IPL section recommends that the following areas be addressed to eliminate deleterious effects in any proposal by the PTO to remove the paper files from the public search room:

Printing – Since copying will not be possible, printing is an issue that should be discussed. Printouts should be easily retrieved by searchers and the cost of printing should be reasonable and reflect the actual cost of producing the printed output.

Adequate Number of Work Stations –Searchers should not have to wait for an available workstation. Therefore, there should be an adequate number of functional work stations such that searchers rarely need to wait for one to become available.

Desk Space – The library currently provides plenty of desk space to public searchers who need a place to spread out their work. Digital work stations should be provided with ample desk space as well.

Aesthetics – The library currently has a unique aesthetic quality that echoes the aesthetics of great historical libraries. Aesthetics was not mentioned in plan proposal, and we urge the PTO to consider aesthetics an important aspect of the new electronic public search facility.

Processor Time / Search speed – With paper files, you can flip through paper patents very rapidly. The PTO should ensure that the electronic search systems permit searching at a rate comparable to (or better than) searching manually.

Classification Index – Paper files were maintained in order of classification. There should be no move by the PTO to abandon the classification system, as it remains an effective search tool.

Foreign Art Collections – With the loss of Examiners' art collections in "shoes," free public access to foreign art collections at the PTO is eliminated. The IPL encourages the PTO to explore relationships with WIPO, EPO, JPO and other national patent offices to establish comprehensive searching of foreign art at the PTO.

Assistance – With paper searches, the only assistance necessary was in pointing the person to the patents they wanted to view. The electronic systems are much more complex and adequate assistance should be made available to members of the public learning to use the electronic systems for the first time. The software should be user friendly and the interface should be as intuitive as possible. However, the search tools should also be capable of powerful searches as would be expected of professional searchers.

Hours of operation – We ask that the hours of operation not be reduced.

Above all, the IPL section encourages the PTO to ensure the highest integrity and quality for the electronic records. It is crucial that the electronic records be maintained up to date, and in searchable form. Furthermore, it is important that there be easy access to the electronic records, with easy and quick access to non-text images, including drawings and chemical structures. Without the ability to review these parts of the patent, any electronic access is insufficient and cannot replace the paper files. The search engines must allow for use of wildcards, truncators, expressions, proximity operators and the (and) and (or) functions, as well as classified searches.

II. TRADEMARK FILES

The IPL Section of the ABA does not object to the PTO proposal to remove paper files relating to trademarks from its public search facilities. Our members report that most practitioners are already using on-line services, either the PTO site or commercial services, primarily if not exclusively. We also note that the PTO stopped filing information on new trademark applications in these files last November. As a result, even now it is not possible to conduct a complete trademark search in the paper files. We therefore do not object to the removal of these paper files, and we believe that PTO efforts should now be directed toward monitoring and maintaining the quality of its automated trademark files.

III. OVERALL PLAN OF ACCESS

The IPL section suggests that the plan for any new electronic search facility be a part of an

overall plan to provide free or low-cost public access to patent and trademark documents. Such a plan should include available free or low-cost parking, improved web-based searching, and improved facilities at the regional Patent and Trademark Depository Libraries. With regard to the latter, the IPL section suggests and encourages the PTO to provide EAST/WEST access at the regional Patent and Trademark Depository Libraries. While the section recognizes that search speed at the depository libraries may be limited by the network connection, such access would be very valuable to businesses and individuals alike.